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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|----------------------|------------------|
| 10/073,100 | 02/12/2002 | Makoto Sakaki | F1866.0002/P002 | 3712 |
| 7590 | 09/27/2004 | | EXAMINER | |
| Steven Weisburd DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP 41st Floor 1177 Avenue of the Americas New York, NY 10036-2714 | | | HAMILTON, KIMBERLY Y | |
| | | ART UNIT | PAPER NUMBER | 2635 |
| DATE MAILED: 09/27/2004 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|------------------------------|------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/073,100 | SAKAKI, MAKOTO |
| | Examiner Kimberly Jenkins | Art Unit 2635 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 21 June 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-14 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 12 February 2002 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Response to Amendment

1. The amendments filed on June 21, 2004 of Application No. 10/173100 have been reviewed by the Examiner. The Examiner acknowledges amended claims 1-14 as disclosed on pp. 3-8, and the correction of indefinite claim language of "type", which has been corrected to "characteristics". In turn, the 35 U.S.C. § 112 has been withdrawn.

Response to Arguments

2. Applicant's arguments filed June 21, 2004 have been fully considered but they are not persuasive. As disclosed on p. 9 from lines 16-25, the Applicant argues that Asakura (US 6460073) under 35 U.S.C. 102 (e) rejection of claims 1-14 does not expressively teach a means for "editing the received data based on the characteristics of the user terminal"; however, Asakura does disclose that the format of the message is changed in a manner to be receivable by the receiving terminal (col. 8, lines 38-42). In turn, the 35 U.S.C. 102(e) rejection under Asakura still stands.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) The invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-14 is rejected under 35 U.S.C. 102(e) as being clearly anticipated by Asakura (US 6460073).

Regarding claims 1 and 8, Asakura, who discloses a method and apparatus for transmitting and receiving electronic mail based upon user availability, teaches an arrival information dealing means for transmitting data arrival information (electronic mail 1) through a network (col. 4, lines 30-33). In addition, Asakura teaches the consideration of each user is taken into consideration, because the users 2-1 to 2-n have their separate identification, which is stored in the user access data memory 30 (col. 4, lines 34-42).

Regarding claims 2 and 9, Asakura teaches, as aforementioned, teaches an arrival information dealing means for transmitting data arrival information (electronic mail 1) through a network (col. 4, lines 30-33). In addition, Asakura teaches the consideration of each user is taken into consideration, because the users 2-1 to 2-n have their separate identification, which is stored in the user access data memory 30 (col. 4, lines 34-42). Furthermore, Asakura teaches a receiving means for the reception of the data arrival (read as electronic mail 1) (col. 4, lines 30-32). Asakura also teaches a terminal (device) type storing means, which is read as a user setting memory portion 3 (col. 4, lines 46-48). Moreover, Asakura teaches a data arrival information type determining means (read as transfer device determining means 60) that determines the appropriate device of the user 2-j from the user setting memory 3 (col. 8, lines 27-33). In turn, the data (electronic mail 1) will be converted (or edited) into a receivable form for the devices before being transmitted to the addresses. The terminal may include a facsimile, a mobile phone, and the mail system 10 (col. 8, lines 34-42). Henceforth, the electronic mail system makes it possible to automatically switch the electronic mail 1 either to transfer or not transfer in accordance to the environment of the user (col. 8, lines 61-64).

Regarding claims 3 and 10, Asakura teaches the mail system 10 to have a means to convert (or edit) the data arrival information to suit the device of which the type of data arrival information to be transferred to the corresponding address (col. 8, lines 38-42).

Regarding claims 4-5 and 11 and 12, Asakura teaches the electronic mail system 10 that transmits and receives arrival data (electronic mail 1) through a network (col. 4, lines 30-33). Asakura, as aforementioned above, teaches that the electronic message can be edited to fit the format of the terminal of reception (col. 8, lines 38-42). The user terminal information is stored within the user setting memory portion 3 (col. 8, lines 32-33). Henceforth, in the event that the data arrival information is to be transmitted to the auxiliary transfer devices (terminals), such as cell phones and facsimiles, the radio network, transfer protocol, and connecting systems are automatically taken into consideration (Asakura demonstrates the concept in col. 8, lines 34-38).

Regarding claims 6 and 13, Asakura teaches as aforementioned regarding claims 2 and 9, also teaches that the data obtaining request can be made by the user(s) 2-1 to 2-j (col. 9, lines 9-13).

Regarding claims 7 and 14, Asakura teaches that the terminal type as being read out and stored within the transfer device determining rule memory portion 80, that stores the transfer device (terminal) of each user 2-1 to 2-j to determine the user's location of the terminal as being a "portable terminal" (col. 9, lines 57-65). In turn the terminal information is stored in the event that the user information can be obtain for the appropriate transmission of data.

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Ron et al. (US 6775359) teaches a voice reply to incoming e-mail addresses via email.
- Vanttila et al. (US 5794142) teaches a mobile terminal that has network services activating through the use of a point-to-point short message service.
- Lee (US 6230019) teaches an apparatus and method of displaying short message transmission state information in mobile radio terminals.
- Wayne et al. (US 5006983) teaches a service allocation system that transmits information in correspondence to the user.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Kimberly Jenkins whose telephone number is

571.272.3064. The examiner can normally be reached from Monday to Friday between the hours of 7am - 3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached on 703.305.4704. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kimberly Jenkins
Examiner
Art Unit 2635
10 March 2004

KYJ

MICHAEL HORABIK
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

